

-- CROSS REFERENCE TO RELATED APPLICATIONS

Al
This application is related to U.S. Patent Application No. 09/752,703, filed on December 27, 2000, entitled "METHODS FOR MAKING REINFORCED WAFER POLISHING PADS UTILIZING DIRECT CASTING AND APPARATUSES IMPLEMENTING THE SAME."--

REMARKS

Claims 1-35 are pending. The "CROSS REFERENCE TO RELATED APPLICATIONS" section has been added to include reference to related U.S. Patent Application No. 09/752,703. This new section does not add new matter. U.S. Patent Application No. 09/752,703 has been included in the Information Disclosure Statement filed concurrently with this Amendment.

Rejections under 35 U.S.C. § 103

Claims 1-7, 12-15, 17-21, and 23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Pant et al. (U.S. Patent No. 6,328,642) ("the Pant reference") in view of Jensen et al. (U.S. Patent No. 6,315,634) ("the Jensen reference"). This rejection is respectfully traversed.

Applicants incorporate by reference the remarks to the section 103 rejection of the Request for Reconsideration filed May 31, 2002. As indicated in the aforementioned document, Applicants respectfully submit that under 35 U.S.C. 103(c), as amended by the Inventor's Protection Act of 1999, the Pant reference and the Jensen reference are disqualified prior art and therefore do not support a section 103 rejection against the claimed subject matter. In response, the Office stated that the Pant reference and the Jensen reference qualify

as prior art under another subsection of 35 U.S.C. 102, and has suggested that the cited prior art references are prior art under 35 U.S.C. 103(a). This suggestion is traversed.

Applicants respectfully submit that both the Pant reference and the Jensen reference do not qualify as prior art under section 102 because both the Pant reference and the Jensen reference issued after the filing date of the present application. Consequently, Applicants submit that the cited references improper prior art under 35 U.S.C. 103(c). In response to the Applicants' inquiry regarding this matter, in a voicemail message of November 18, 2002 received from the Examiner, the Examiner indicated that the Pant reference and the Jensen reference would be removed because it is commonly owned.

Applicants note that a foreign counterpart application of the Pant reference was filed and published before the filing of the present application. This reference is cited in the Information Disclosure Statement filed concurrently with this Amendment. Regardless, because the Jensen patent is disqualified prior art under section 103(c), Applicants submit that the section 103 rejection using the combination of the Pant reference and the Jensen reference should be withdrawn.

Claims 8, 16, 22, and 27 were rejected under 35 U.S.C. 103(a) as being unpatentable over Pant et al. (U.S. Patent No. 6,328,642) in view of Jensen et al. (U.S. Patent No. 6,315,634). This rejection is respectfully traversed.

Applicants submit that claims 8, 16, 22, and 27 are patentable for at least the same reasons as claims 1-7, 12-15, 17-21, and 23 above due to 35 U.S.C. 103(c) and the disqualification of the Pant reference and the Jensen reference as prior art. Therefore, Applicants respectfully submit that claims 8, 16, 22, and 27 are allowable and respectfully request that the section 103 rejection be withdrawn.

Allowable Subject Matter

The Office has stated that claims 24-26 and 28-35 are allowed.



Claims 9-11 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants respectfully submit that independent claim 1 is allowable for the reasons stated above, so claims 9-11 are submitted to be in allowable form.

In addition, Applicants submit that the Final Office Action dated August 19, 2002 should not have been a final rejection. The Office is directed to M.P.E.P. section 706.02(l)3 which states in pertinent part:

"When applying any 35 U.S.C. 102(e)/103 references against the claims in applications filed on or after November 29, 1999, the examiner should anticipate that a statement of common ownership may disqualify any patent or application applied in a rejection under 35 U.S.C. 103 based on 35 U.S.C. 102(e). See MPEP § 706.02(l)(1). If such a statement is filed in reply to the 35 U.S.C. 102(e)/103 rejection and the claims are not amended, the examiner may not make the next Office action final if a new rejection is made."

Therefore, Applicants respectfully request that the Office withdraw the finality of the Office Action dated August 19, 2002.

Applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. If the Examiner has any questions concerning this paper, the Examiner is kindly requested to contact the undersigned at (408) 749-6900. If any additional fees are due in connection with the filing this paper, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No. LAM2P223A).

Respectfully submitted,
MARTINE & PENILLA, L.L.P.


Edmund H. Mizumoto, Esq.
Reg. No. 46,938

Martine & Penilla, LLP
710 Lakeway Drive, Suite 170
Sunnyvale, California 94085
(408)749-6900

Attorney Docket No. LAM2P223A

A